

7. The microporous heat insulation body according to claim 5, characterized in that one or both surfaces have a cover of a heat-resistant material.

8. The microporous heat insulation body according to claim 7, characterized in that the covers are the same or different and consist of pre-compressed xonotlite, mica, or graphite.

9. The microporous heat insulation body according to claim 7, characterized in that the cover consists of a prefabricated mica sheet on both surfaces.

REMARKS

The instant Office Action does not acknowledge receipt of the certified copy of DE 19859084.9, filed December 19, 1998, relied on for priority under 35 USC 119, as indicated on the Notification of Acceptance, mailed 31 July 2001. Applicant requests that the Examiner mark the next Office Action to acknowledge receipt of the certified copy, which receipt was priority document Claims 5-9, presented hereby, are pending.

Claim 5 represents subject matter from original claim 1 and as described in the specification at page 4, 2nd complete paragraph. Claim 6 represents subject matter of original claim 1. Claims 7-9 represent the subject matter of original claims 2-4, respectively. In order to more clearly define the invention, claim 5 recites --comprising--, since dependent claims 7-9 add a feature of the "body" of claim 5 (as added by original claims 2-4 to that of original claim 1). Further, claim 7 recites

--surfaces--, instead of "sides" (as in claim 4), to more clearly define the invention, i.e., by reflecting clearer antecedent basis.

Reconsideration is requested with respect to the rejection of claim 1 under 35 USC 112, ¶2, in view of the instant Amendment. The term "preferably" is not recited in the present claims. Subject matter associated with "preferably" as recited in claim 1 is made the subject of new dependent claim 6.

Reconsideration is requested with respect to the rejections of the original claims under 35 USC 103(a) in view of the new claims submitted, hereby, and the following remarks.

The presently claimed invention is directed to a microporous heat insulation body of heat insulation materials "manufactured by dry compressing." To "manufactured by dry compressing," the ingredients are mixed and compressed. Under these conditions such materials normally show a high resilience called "spring back." Surprisingly, the addition of xonotlite as one of the ingredients prevents this spring back and improves stability of the "body."

In example 1 of the specification, a comparative example containing no xonotlite is provided. Example 2 describes the instant invention, i.e., the addition of xonotlite to the comparative example. As can be derived from the Table in the specification, the addition of xonotlite reduces the resilience and increases the bending strength of the microporous heat insulation body, in accordance with the of the presently claimed invention.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). When conducting an obviousness analysis, “all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference.” *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). When the claimed invention requires modification of the prior art, there is no obviousness under §103 when “[t]he prior art does not suggest . . . modification of the . . . [prior art], or provide any reason or motivation to make the modification.” *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). The totality of each reference's teachings must be considered when combining those teachings with the rest of the prior art. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciate of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

The statement of rejection considers claim 1 as being unpatentable over Kratel in view of Andersen et al.

Kratel teaches a microporous thermal insulation molding. According to Kratel (column 3, lines 20 to 31) the product of Kratel comprises channel pores prepared by drills, punches, milling

cutters, or embossing stamps. As acknowledged in the statement of rejection, Kratel does not teach including xonotlite in the described product.

According to the statement of rejection, a person skilled in the art would have considered it obvious to add xonotlite to the product of Kratel to provide more flexibility, as allegedly taught in Andersen. Applicant submits that the reliance on Anderson is misplaced.

Anderson teaches the use of a cementitious structural matrix. It is formed from hydraulic cement, water, fibrous materials, appropriate aggregate materials, plasticizers, and/or rheologically modifying agents. Whereas, the presently claimed invention is related to an insulating material prepared in the dry state, i.e., "manufactured by dry-compressing," Anderson discloses a water-based cement material.

Anderson mentions the addition of xonotlite, but only as one example out of a list of aggregates (Anderson, column 16, line 57, to column 17, line 9). These aggregates are used in order to make the resulting material lightweight. They do not add any additional functional property.

The statement of rejection alleges that the xonotlite aggregate as taught in Anderson would have been used in Kratel by the skilled artisan motivated to add flexibility to the Kratel material. This is not correct.

According to Anderson, "flexibility" is imparted by use of "fibrous aggregates" (Anderson column 17, lines 40-44). Anderson (column 17, lines 45-48) expressly reserves the word "aggregates," by itself, to "refer to all other filler materials which are nonfibrous" i.e., by implication,

filler materials that do not impart flexibility. Accordingly, Andersen does no more than teach xonotlite as a possible filler in the preparation of a cementitious, water-based material.

Consideration of the complete teachings of Anderson requires an appreciation that the reference neither teaches nor suggests that xonotlite adds flexibility. *Garlock Inc., supra. Hedges, supra.* Therefore, Andersen provides no motivation for modifying Kratel to include xonotlite, as alleged in the statement of rejection. *Laskowski, supra.* Since there is no teaching or suggestion in the cited prior art to modify Kratel to include a limitation on the present claims that is missing from the reference, the presently claimed invention would not have been obvious under §103(a) based on the combined teachings of Kratel and Anderson. *Royka, supra. Wilson, supra. Murphy, supra.*

None of the other references relied on to reject the claims, taken alone or in combination, cures the fatal deficiencies in combined teachings of Kratel and Anderson, as explained above. Accordingly, applicant submits that none of the rejections of record under 35 USC 103(a) can be maintained against the present claims.

Moreover, Anderson would have provided no hint to include xonotlite in a dry material, as presently claimed.

Applicant submits that, furthermore, including small amounts of water to the materials recited in the present claims, followed by dry pressing, produces less effective products with respect to their heat-insulation properties.

Claims were provisionally rejected for alleged obviousness type double patenting over a copending application. Unless and until such time as there are patented claims, on the one hand, and

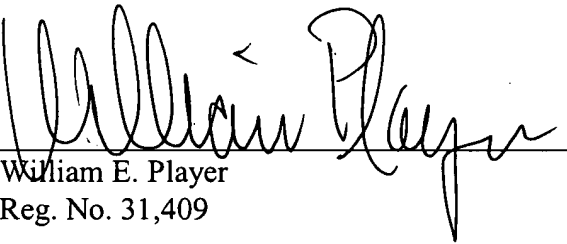
allowable claims, on the other, there is no way to determine whether obviousness type double patenting, in fact, exists. Absent a finding of obviousness type double patenting, in fact, it would be premature for Applicant to address such a rejection, including by filing a terminal disclaimer. In the event such finding is made, i.e., the rejection is no longer provisional, Applicant will address the rejection.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:



William E. Player
Reg. No. 31,409

The Jenifer Building
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666
Atty. Dkt. No. P66718US0
Date: April 22, 2002
WEP/rdt
R:\HOME\rthomas\2002\April\P66718US0-Amdt